

Wilson, James

From: Wilson, James
Sent: Sunday, May 02, 2004 6:46 PM
To: Wilson, James
Subject: Decision on 08/648,270 Appeals conference

This subject matter is indeed allowable.
Your 112 1st rejections under enablement
and written description are poorly developed
and I deem them to be improper.

Note:
Office personnel must always remember to use
the perspective of one of ordinary skill in the art.
Claims and disclosures are not to be evaluated
in a vacuum. If elements of an invention are well
known in the art, the applicant does not have to
provide a disclosure that describes those elements.

See specification text of US Patent 5,824,796
Note the case is a continuation of a case dating back
to 1989.

See also 5,047,519
This case was filed in 1987.

Tagged and/or highlighted disclosure shows the use of
palladium mediated coupling of a halogenated nucleoside
to give an acetylene-coupled product or an alkynyl-coupled
product are indeed well known in the art. Your search should
have helped you establish this as fact.

You are to allow this case or object to the specification to
establish that the disclosure attempts to incorporate
essential subject matter, see pages:

Page 19, lines 17-18
Page 20, lines 2-3 following Scheme V
Page 22, lines 13-14.

Even if you choose not to object to the specification, the
claims are enabled in view of the knowledge one skilled in
this art possessed at the time the invention was made.